

REMARKS

In the Office Action, claims 1-10 were rejected. By the present Response, Applicant has added new claims 33-37. With respect to these new claims, Applicant respectfully asserts that no new matter has been added. Additionally, Applicant notes that claims 11-19 and 26-32 are withdrawn from consideration. Upon entry of the amendments, claims 1-10 and 33-37 will be pending. Applicant respectfully requests reconsideration and allowance of all pending claims in view of the foregoing amendments and the following remarks.

Rejection Under Section 102

In the Office Action, claims 1, 2, and 4-10 were rejected under 35 U.S.C. § 102(b) as anticipated by the Keller et al. reference (U.S. Patent No. 4,145,595; hereinafter "Keller"). In regard to this rejection, the following interpretation of Keller was presented:

Keller et al disclose a welding implement comprising a torch head (10) and a thermal storage member (27) adapted to absorb heat from the torch head (10), wherein the thermal storage member is electrically isolated from the torch head by insulator (28) shown in figure 3.

As to claim 4, further comprising [an] electrically conductive tube (26) to conduct electricity and gas to the torch head, wherein the thermal storage member is disposed around at least a portion of the tube (figure 3).

As to claim 7, wherein the tube (26) is a first conductive metal and thermal storage (27) is a second conductive metal.

As to claim 8, the torch is capable to be air-cooled and operable to conductor 300 Amps at a 60% duty cycle with a temperature increase of less than 30K.

As to claim 9, a second tube (31) is disposed around the portion of the tube (26).

Office Action mailed January 25, 2005, pp. 3-4 (emphasis added).

Applicants, however, respectfully asserts that Keller does not anticipate the present claims, because these claims recite features not disclosed by Keller. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). Thus, for a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the identical invention “in as complete detail as contained in the ... claim” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicant needs only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

With respect to independent claim 1, Applicant respectfully asserts that Keller does not disclose “a thermal storage member adapted to absorb heat from the torch head, wherein the thermal storage member is electrically isolated from the torch head,” as is recited in the instant claim. (Emphasis added.) Rather, Keller discloses that the cylindrical connector 27—which is alleged as being anticipatory of the claimed thermal storage member—is electrically coupled to the holder section 10 (i.e., torch head). Keller states that connector 27 is configured to receive a cable coupler that provides welding current and pressurized, inert gas to the torch. *See* Keller, col. 4, ll. 34-40. In the Keller device, welding current is routed from the connector 27 into a “highly-conductive metal pipe 26” that is joined at one end to the connector 27 and welded at the other end to a flexible helix 25 formed of a “metal or alloy of high conductivity,” thus facilitating the routing of welding current into the helix 25. *See id.* at col. 4, ll. 15-20; col. 4, ll. 29-31. In turn, the helix 25 is brazed to the “highly conductive” coupler 23, which is electrically coupled to the barrel 12 that support the electrode 13. *See id.* at col. 3, ll. 48-50; col. 4, ll. 10-17. Thus, for current to reach the electrode 13 for operation, the connector 27 of the

Keller device must be in electrical communication with torch head 10. Indeed, if the connector 27 were to be electrically isolated, no path for welding current from the welding cable to the torch head would exist, making the Keller device inoperable. Moreover, although Keller discloses a body 28 that surrounds the helix 25, this body 28 isolates the external environment from inadvertent electrical shock, and does not electrically isolate the helix 25 from the connector 27, nor does it electrically isolate the connector 27 from the barrel 12 in the torch head 10. Thus, Applicant respectfully asserts that Keller does not disclose all of the features recited in independent claim 1.

Additionally, Applicant respectfully asserts that Keller does not all of the features recited in the dependent claims. For example, Applicant respectfully asserts that Keller does not disclose a torch head that is “operable to conduct 300 Amps at a 60% duty cycle with a temperature increase of less than 30K.” as recited in dependent claim 8. Respectfully, Applicant asserts that it has not been shown that Keller necessarily discloses the torch head in as exact detail as recited. Rather, in view of the above-quoted rejection, it appears that the Examiner is asserting that Keller inherently discloses a torch head conforming to the recitations of claim 8. However, Applicant respectfully asserts that a theory of inherency requires that extrinsic evidence (e.g., a cited reference) must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.* In the present case, Applicant respectfully asserts that simple citation to Keller as a whole without any accompanying logic does not demonstrate that Keller does or even could disclose a torch head as recited in dependent claim 8.

Based on the foregoing, Applicants respectfully asserts that Keller does not anticipate independent claim 1. Moreover, Applicant respectfully asserts that dependent

claims 2 and 4-10 are patentable over Keller not only by virtue of their respective dependencies to allowable independent claim 1, but also by virtue of the additional features recited therein. Thus, Applicant respectfully requests reconsideration and allowance of claims 1, 2 and 4-10.

Rejection Under Section 103

In the Office Action, claim 3 was rejected under 35 U.S.C. § 103(a) as obvious in view of Keller. Applicant, however, respectfully asserts that the obviousness rejection in view of Keller does not overcome the deficiencies of Keller discussed above in reference to independent claim 1. Thus, Applicant respectfully asserts that dependent claim 3, which depends from independent claim 1, is patentable not only by virtue of its dependence on an allowable based claim, but also by virtue of the addition features recited therein. In view of the foregoing, Applicant respectfully requests reconsideration and allowance of dependent claim 3.

New Claims

As discussed above, Applicant has added new claims 33-37 by the present Response. Applicant respectfully asserts that these new claims are patentable over the Keller reference as well as the prior art in general. Keeping in mind the foregoing remarks with respect to claims 1-10, Applicant respectfully requests allowance of new claims 33-37.

Conclusion

If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Date: April 25, 2005

Manish Vyas
Reg. No. 54,516
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545